

DOCKET NO.: CSAC-0009
Application No.: 09/782,337
Office Action Dated: February 24, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

AMENDMENTS/REMARKS

This is in response to the Official Action dated February 24, 2003, issued in connection with the above-identified application. Allowance of all pending claims is respectfully requested in view of the following.

RECEIVED
JUN 26 2003
TC 1700

Status of the Claims

Upon entry of the foregoing amendments, claims 1-7, 9-16, 18-23, and 29-31 will be pending in the application. Claims 1, 9, 12, 18 and 28 have been amended; claims 8, 17, and 28 have been cancelled. No new matter has been introduced.

Claim Amendments

Claim 1 has been amended to recite that the first and second films comprise polyolefin and are heat-laminated to the foam sheet. Support for these amendments may be found in the specification as originally filed at, *inter alia*, page 3, line 19 through page 4, line 15; page 4, lines 26-27; and page 11, lines 17-30.

Claims 8, 17, and 28 have been cancelled because they are duplicative in light of the amendments to claim 1.

Claims 9, 18, and 29 have been amended to correct dependency of those claims in light of the cancellation of claims 8, 17 and 28.

Claim 12 has been amended to correct a typographical error.

Rejections Under 35 U.S.C. §103(a):

Claims 1-12, 15-23, and 28 were rejected under §103 as allegedly being unpatentable over Akao (U.S. Patent No. 4,469,741) in view of Foster (U.S. Patent No. 5,968,630). Applicants respectfully submit that these rejections have been overcome by the amendments made to claim 1. Akao requires the use of an adhesive layer between a foam layer and a film layer. (See Akao at, *inter alia*, column 1, lines 47-65 and column 2, lines 10-14.) Thus, the invention of Akao as modified by Foster will never result in a product in which a film layer is heat-laminated to the foam. The combination of Akao and Foster would instead result in a film or films attached to a foam layer by way of adhesive layers between the film and foam layers. In contrast, newly amended claim 1 recites the use of heat-lamination to attach the film to the foam, thus obviating the need for an adhesive layer. Therefore, because a *prima*

facie case of obviousness requires that “the prior art reference (or references when combined) must teach or suggest all the claim limitations,” the present invention is not rendered obvious by Akao in view of Foster. (MPEP §2143.)

In fact, Akao specifically discourages the use of heat lamination. Akao states that “the method of heat-sealing the films is also not desirable in that heat shrinkage of the film is caused at areas where heating is applied, resulting in the formation of wrinkles which is not desirable from a viewpoint of quality.” (Akao at column 1, line 66 to column 2, line 2.) This statement further supports a conclusion that the present invention is unobvious, because there must be some suggestion or motivation to modify the reference or to combine reference teachings. (MPEP §2143.) Akao clearly does not provide such a motivation. To the contrary, it teaches away. Applicants’ having proceeded in a direction that the art suggests should be avoided is affirmative evidence of non-obviousness.

Claims 1-23 and 28-31 were also rejected under §103 as allegedly being unpatentable over Foster in view of Deibel (U.S. Patent No. 6,358,599). Applicants respectfully submit that these rejections are also overcome by the amendments to claim 1. Deibel teaches a foam board comprising a panel of a plastic foam material and at least one thermoplastic facer adhered to at least one surface of the panel, in which the facer comprises a polymer blend containing an alkenyl aromatic polymer or copolymer. (Deibel at column 3, lines 26-30.) In contrast, newly amended claim 1 recites that the first and second film sheets comprise polyolefin. Thus, Foster (foam with film on only one side) in combination with Deibel (foam with alkenyl aromatic polymer film on one or both sides) will result in a foam with an alkenyl aromatic polymer film on at least one side, not in a foam layer with *polyolefin* films heat-laminated to both a first and second surface of the foam. Because a *prima facie* case of obviousness requires that “the prior art reference (or references when combined) must teach or suggest all the claim limitations,” the present invention is also not rendered obvious by Foster in view of Deibel. (MPEP §2143.)

Additionally, no motivation exists to combine Foster with Deibel in such a way as to form the present invention in the first place. Deibel teaches that the films used therein should be compatible with the foam material to allow recycling of the resulting foam board. (Deibel at column 3, lines 49-52.) Deibel further teaches that polyolefin films are not sufficiently recyclable and are therefore inappropriate for use in the composition described in the reference. (Deibel at column 3, lines 9-16.) These points further refute a finding of obviousness, because a *prima facie* case of obviousness requires some suggestion or

DOCKET NO.: CSAC-0009
Application No.: 09/782,337
Office Action Dated: February 24, 2003

**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

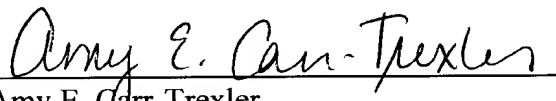
motivation to modify the reference or to combine reference teachings, which clearly is discouraged by Deibel. (MPEP §2143.)

In view of the foregoing amendment and remarks, Applicants respectfully request the reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

Conclusion:

Applicants respectfully submit that the foregoing arguments place this application in condition for allowance. Applicants invite the Examiner to contact the undersigned at (215) 557-5966 to clarify any unresolved issues raised by this response.

Date: June 24, 2003


Amy E. Carr-Trexler
Registration No. 51,531

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439